

REMARKS

Claims 1,2 and 4-16 are pending. Claim 1 is amended herein. Claim 1 has been amended to include the features of original claim 3. Further, the amendments to claim 1 are at least additionally supported by paragraphs [0001] and [0076] of the specification. Claim 3 has been canceled herein without prejudice or disclaimer.

It is respectfully submitted that this paper is fully responsive to the Office action mailed on August 19, 2008.

Applicants' Response to the Claim Rejections under 35 U.S.C. §103

Claims 1-8 and 10-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shibahara (US 7,132,154) in view of Border (US 2002/0123550 A1).

In response thereto, applicants respectfully submit that the presently claimed invention would not be obvious for at least the reason that there is no basis whereby one of skill in the art could combine the references so as to derive the claims.

In regard to claim 3, now incorporated into parent claim 1, the rejection asserts that since Shibahara teaches that the glass filler (b) is present in an amount of 30 to 70% by weight, for the purpose of reducing the linear expansion coefficient of the resin sheet and that a second inorganic filler may be used, such as glass particles: "it would have been obvious to one of ordinary skill in the art, to have added silica particles in an amount within the claimed range of 15 to 60 weight %, to the resin layer, in addition to the glass fiber cloth-like material, to fill in the portions of the

resin layer that is not occupied by the glass fiber cloth-like material, for the purpose of further reducing the linear expansion coefficient of the resin sheet.” See pages 4-5 of the Office Action.

However, Shibahara specifically discloses “glass cloths are most preferred” as the glass filler (b), following the citation of various forms of the glass filler, such as glass cloth and glass particles. See col. 9 lines 1-8. Shibahara also discloses in the subsequent paragraph that the glass filler (b) is incorporated in an amount of preferably 30 to 70%. See col. 9, line 15. Accordingly, since the rejection concludes “Shibahara discloses glass cloth” as a common feature in comparison between the present invention and Shibahara, this means that the “glass cloth” would need to have been selected from among various forms of the glass filler (b) by the skilled artisan. Thus, one of skill in the art would interpret that the amount represented by “30 to 70% by weight” represents the amount of the “glass cloth” selected.

In other words, Shibahara does not provide any reason whereby a skilled artisan could derive that selecting the “glass cloth” as a most preferred form of the glass filler, the amount of “30 to 70% by weight” is applied to a different form of the glass filler as required by the rejection. Hence, one of skill in the art could not derive this aspect of applicants’ claim 1 based on the teachings of Shibahara.

Further, regardless of “glass cloth” being selected from among various forms of the glass filler (b) in comparison between the present invention and Shibahara, there is no basis for the rejection’s application of the limitation “30 to 70% by weight” to the “glass particles” and conclusion that it would have been obvious to have the glass particle added in an amount of 15 to

60% by weight (in addition to the “glass fiber cloth-like material”). Rather, the teachings of Shibahara are directed to an opposite conclusion. Namely, Shibahara teaches only “a small amount” of a second filler as a “loading material.” This teaching is contrary to the rejections position that it would be obvious to use two glass fillers of varying amounts within the range of 30-70wt% wherein one filler would be a glass fiber cloth-like material and the other would be the inorganic particle. In regard to the teachings of Boarder, the reference is not relied upon for any equivalent disclosures. Hence, there is no basis whereby a skilled artisan could combine the teachings of Shibahara and Boarder to derive the claimed invention pursuant to amended claim 1.

In light of the above, applicants respectfully submit that parent claim 1 and its respective dependent claims are not obvious under 35 U.S.C. §103 in light of the combination of Shibahara and Boarder.

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shibahara (US 7,132,154) in view of Border (US 2002/0123550 A1) as applied to claims 1-8 and 10-16 above, and further in view of Babb (US 5,730,922).

Applicants’ respectfully submit that by addressing the rejection to parent claim 1 as detailed above, the rejection of claim 9 should likewise be considered addressed based on its dependency.

Application No.: 10/580,714
Art Unit: 1794

Response under 37 CFR §1.116
Attorney Docket No.: 062568

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, reading "Michael J. Caridi", with a long horizontal flourish extending to the right.

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